

REMARKS

Applicants thank the Examiner for the thorough examination given the present application.

Status of the Claims

Claims 7-12 and 15 are pending in the above-identified application. Support for the recitations in amended claim 7 can be found in paragraph [0064] of the publication of the present specification, which mentions the wiped film evaporator. In Examples 1-2 (paragraphs [0117] and [0120]), solutions were subjected to distillation using a WFE-type thin film evaporator once, which means a single pass through the wiped film evaporator. Thus, no new matter has been added. Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 112, first paragraph

Claims 7-12 and 15 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (page 2 of the outstanding Office Action). Specifically, the Examiner states that the phrase “the purification by distillation is carried out in a single pass” in claim 7 lacks support in the present specification. Applicants respectfully traverse.

The claims have been amended in an effort to overcome this issue. Thus, Applicants respectfully request that the rejection be withdrawn.

Issues under 35 U.S.C. § 103

The Examiner has rejected claims 7-12 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Takai ‘618 (US 2003/0059618) in view of Ryan et al. ‘297 (US 5,880,297) (pages 2-5 of the outstanding Office Action). Applicants respectfully traverse, and reconsideration and withdrawal of the rejection are respectfully requested.

Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. See MPEP 2143.03.

Distinctions over the Cited References

On page 4 of the outstanding Office Action, the Examiner states, “At the time of the invention a person having ordinary skill in the art would have found it obvious to combine the wiped film evaporator of Ryan et al. with the process of Takai and would have been motivated to do so for such desirable properties as obtaining a low color product which is highly pure, as evidenced by Ryan et al. (col. 2 lines 54-63).”

However, this section of Ryan et al. ‘297 describes that glycidyl esters are thermally and chemically reactive molecules and that standard atmospheric distillation techniques have been found to increase the amount of by-products as well as the degree of color of the esters. These are specific properties of glycidyl esters. Therefore, the reasons for selecting a wiped film evaporator are also specific for glycidyl esters.

In contrast, the object of Takai '618 is to provide an epoxy resin composition which provides a cured product having excellent moisture and heat resistance and transparency. Further, the epoxy compounds with an ester bond have hydrolyzability, they are reactive under high temperature and humidity, and the cured product may be reduced in the physical property (Takai '618, paragraphs [0006]-[0007]). The non-ester compound according to Takai '618 does not have the above-described properties of glycidyl esters of Ryan et al. '297. Therefore, the reasons for selecting a wiped film evaporator for Ryan et al. '297 are not applicable to Takai '618.

As discussed above, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the outstanding rejection is respectfully requested. Any contentions of the USPTO to the contrary must be reconsidered at present.

Obviousness-Type Double Patenting

The Examiner has provisionally rejected claim 7 under the doctrine of obviousness-type double patenting over claim 20 of co-pending Application No. 11/792,782 (pages 5-7 of the outstanding Office Action).

Applicants note that the present application has an earlier filing date than the filing date of the '782 Application. As such, if a provisional obviousness-type double patenting rejection is the only rejection remaining, the Examiner should withdraw the obviousness-type double patenting rejection in the earlier filed application (in this case, the present application) thereby permitting that application to issue without need of a terminal disclaimer (MPEP 804(I)(B)(1)).

CONCLUSION

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case clearly indicating that each of claims 7-12 and 15 are allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: **NOV 30 2009**

Respectfully submitted,

By 

Marc S. Weiner

Registration No.: 32,181

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicants